

REMARKS

Claims 1-3, 5-7, 10, and 16-18 are pending. Claims 1, 3, 5, 7, and 16 have been amended. The changes to claims 1, 5, 7, and 16 are supported by FIG. 78 and the text related thereto, for instance. Applicant respectfully requests reconsideration of the application.

Claim Rejections – 35 USC §112

Claim 5 has been rejected under 35 U.S.C. §103(a), second paragraph as being indefinite. More specifically, there is insufficient antecedent basis for the limitation “the mark and the space” of claim 5. Amendments to claim 5 obviate these rejections. Withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 USC §103

Claims 1-7, 10, and 16-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. (hereinafter Nakajima) (US 2002/0001274) and Applicant's Admitted Prior Art (AAPA) and further in view of Nakajima et al. (US 2001/0036134). This rejection is respectfully traversed.

As recited in amended claim 1, the Lead-In area includes “a specific area having a bi-phased High Frequency Modulated (HFM) groove and patterns of straight pits formed on the basis of the HFM groove.” In rejecting claim 1, the Office has correctly noted that the Nakajima et al. publication does not specifically disclose where the groove is a bi-phased HFM groove. Then, in an attempt to overcome the deficiency in failing to teach the HFM groove, the Office has relied on AAPA and stated that the

AAPA disclosed forming pre-pits associated with a bi-phased (High Frequency Modulated) groove (Figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide the modulation method of AAPA to the optical recording medium of Nakajima,

motivation being to efficiently record control data to the lead-in area of the disc.

Applicant respectfully disagrees with the applicability of this legal standard and the conclusion of obviousness. As discussed in the Background section of the present application, the AAPA system has a HFM groove in the lead-in area. (See figure 2.) However, AAPA is silent as to straight pits formed in the lead-in area, much less an area having both a HFM groove and straight pre-pits. Thus, it is not clear why a skilled artisan would be motivated to add straight pits to the groove of AAPA insofar as the straight pits are seemingly redundant for proper operation of the AAPA systems. Likewise, it is illogical to form a HFM groove in the Nakajima et al. system insofar as a HFM is seemingly redundant for proper operation of the Nakajima et al. systems. For a proper obviousness rejection, the Office must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" and not "mere conclusory statements." *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)). As the Office has failed to provide any reasoning to support the legal conclusion, Applicant is left to deduce that only through impermissible and improper hindsight reconstruction has the Office been able to piece together isolated disclosures in Nakajima et al. and AAPA in an attempt to arrive at Applicant's claimed invention. It is well settled that such hindsight reconstruction is improper.

In addition, the hypothetical combination would not meet the straight pits recited in claim 1. FIG. 5A of the Nakajima et al. publication shows a groove and marks, where the marks are located in the groove. Thus, even if one were to assume, *arguendo*, that the groove of the hypothetical system were a HFM groove, the marks would have a wobbled pattern since the HFM groove would be wobbled. Thus, the hypothetical system would not have a pattern of **straight** pits. Perhaps more

importantly, both the Nakajima et al. and AAPA are silent as to a pattern of straight pits on the basis of an HFM groove as recited in claim 1.

In light of the foregoing, Applicant respectfully submits that a *prima facie* case of obviousness has not been established, and that claim 1 is allowable. Claims 7 and 16 contain similar claim language as that cited above with respect to claim 1 and are allowable for at least the reasons indicated above with respect to claim 1. Claims 2-6, 10, and 17-18 depend, either directly or ultimately, from claims 1, 7, and 16, rendering them also allowable for at least the same reasons as set forth above.

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CONCLUSION

In view of the above remarks and amendments, the Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Pursuant to 37 CFR §§ 1.17 and 1.136(a), Applicants petition for a one (1) month extension of time for filing a reply to the October 29, 2008 Office Action, and submit the required \$130 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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